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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,005	11/20/2001	Eleanor L. Schuler	0607-1006	7962
7590	02/25/2005			
William M. Lee, Jr. Barnes & Thornburg P.O. Box 2786 Chicago, IL 60690-2786			EXAMINER MARMOR II, CHARLES ALAN	
			ART UNIT 3736	PAPER NUMBER

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,005

Applicant(s)

SCHULER ET AL.

Examiner

Charles A. Marmor, II

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3736.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the Decision to Grant the Petition to Withdraw Holding of Abandonment of September 24, 2004. In view of the decision, this Office Action is further responsive to the Amendment filed March 5, 2004. The Examiner acknowledges the amendments to claims 6 and 11, as well as the addition of new claims 16-20. Claims 1-20 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Humphrey ('239). Humphrey teaches systems methods and devices for stimulating and regulating body organ function, particularly in relation to paralyzed muscles of an arm (Figures 1, 10, 11). The method includes collecting waveforms that are representative of waveforms naturally occurring within a body from a body; at least temporarily storing the collected waveforms in a computer processor (9); and transmitting one or more collected waveforms to the body organ to stimulate organ function. The collected waveforms are transformed from analog signals into a readable

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digital format for the computer processor. The collected waveforms are stored according to the function performed by the waveforms. The collected waveforms are transmitted to the paralyzed muscles through a stimulation controller that converts the digital signals to analog signals. The system includes a computer (9) forming a source of collected waveforms; means for transmitting at least one of the collected waveforms to a body organ; and means for applying the transmitted waveforms to the body organ via nerves. The transmitting means includes a digital to analog converter and the applying means can include a body electrode applied to the paralyzed muscles of the arm. The computer at least temporarily stores the waveforms in a digital format in separate storage areas (102) for collected waveforms of different functional categories. Recording electrodes (5) are placed on the body to collect the waveforms in analog form and transmit the waveforms to the computer source.

Response to Arguments

4. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Applicant contends that Bourgeois teach an implanted device that transmits artificially generated waveforms for stimulation of the gastrointestinal tract, but fails to teach or suggest detecting waveforms that are generated by the body and using these specific waveforms. Applicant further contends that Leichsenr discloses an electrical stimulator for tissue and nerve cell structures that includes a storage register for desired waveforms; however, there is no teaching in Leichsenr that the waveforms are representative of naturally occurring waveforms or were collected from a body. While the Examiner does not concede that

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all of Applicant's arguments are fully persuasive, these arguments are moot in view of the new grounds of rejection set forth hereinabove, citing Humphrey.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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February 18, 2005